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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,709	08/31/2000	Oscar Lee Avant	08049.009	3489

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EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,709

Applicant(s)

AVANT ET AL.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) 105-158 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it does not describe the invention as claimed in the elected claims. Correction is required. See MPEP § 608.01(b).

Election/Restrictions

It is acknowledged that no response and/or traversal has been made in electing Group I. Group II, Claims 105-158 are here removed from consideration by the Examiner.

Drawings

Figures 1-5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent method and apparatus claims all recite conditional method steps and constructional elements, respectively. The first few lines of each independent claim recite sorting mail based on a code on the front of the mailpiece, if there is a code on the front of the mailpiece.

Thus, the desire by the applicant to obtain claim coverage of all subject matter following this recitation is in question. The claims, which are meant to describe the method of sorting or the apparatus therefor, go no further than this recitation in the case of a mailpiece having a code on the front. In the absence of the code on the front, the claim as previously interpreted ceases to exist and is substituted by a claim wherein a code is read from the back. The claims do not stay constant in time. In the case where all mail items have codes on the front, the claims recite no more than is previously known in the art. Wherein, the claim takes new meaning in the scenario wherein all mailpieces arrive with a code on the back, whereupon these claims shift to new meaning and still apply to old methods and devices known well in the art which utilize a code on the back of the mailpiece.

Further, in the case that someone deposited mailpieces all omitting a code, the mailpiece would be acted upon by the method/apparatus also known in the art, in which a database is set up and two codes are marked on the mailpiece which correspond to the address processed by an OCR.

All dependent claims recite limitations which pertain primarily to the secondary and tertiary tiers of the conditional claim, and therefore have been considered as not applying to the method/apparatus which exists in a world where 100% of all mailpieces comprise a code on the front.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,667,078.

Claims 1-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by admitted prior art.

Claims 1-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,249,687.

Please note that the Examiner interpreted all of the claims as only comprising a single step/element in/by which mail is sorted using a code on the front. Nothing after this conditional recitation has been considered, all subsequent recitations having been granted no patentable weight in light of their conditional existence in application.

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Both the references and the background summary of the instant application describe a method/device in which mail is sorted based upon a code residing on the front of the mailpiece.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Many of the cited references teach methods/apparatuses which include methods in which the other, non-inferred conditions of the independent claims are described.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.


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April 2, 2002


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
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